

REMARKS

Claims 1 is amended herein by inserting aid low-density polyethylene” in line 10 after “low-density polyethylene” as suggested by the Examiner. No new matter is presented.

I. Response to 35 U.S.C. § 112, first paragraph

1. Objections to the Specification

The specification is objected to for alleged inadequate written description of the invention, and alleged non-enablement.

The Examiner recognizes that Applicants are not required to explain how or why the invention works but asserts that the Examples (presumably Example 2 in particular) are inconsistent with the remainder of the disclosure. In this regard he continues to express specific concern that the Examples show significantly different results with only very small changes in density while the specification teaches and the claims recite wide ranges of preferred densities of both HDPE and LDPE.

In view of these perceived inconsistencies, the Examiner concludes that disclosure merely invites experimentation as opposed to adequately describing and enabling the claims.

2. Claim Rejection

Claims 1,2, and 5-9 are rejected under 35 U.S.C. §112, first paragraph, as being based on an allegedly non-enabling disclosure for the reasons discussed above.

Applicants respectfully traverse the rejection.

Applicants submit the fact that significantly different results are obtainable with only very small changes in density is not a basis for objecting the specification as non-enabling or as failing to contain an adequate written description. The Examiner has not appropriately

considered that the Examples are based on measured results and can be reproduced based on the content of the disclosure. Moreover, the fact that marked changes in properties are observed due to only small changes in density in an art that the Examiner characterizes “predictable” only further supports an argument of unexpected superiority. Thus, the Examiner’s assertion of this point is misplaced to the extent that the Examiner relies upon it to conclude that the specification is non-enabling or lacks adequate written description.

The extent to which the Examiner relies on the results of the Examples to assert the disclosure is inconsistent is a separate issue. The fact that densities taught by Applicants may not produce the results of the same level of superiority as the presently claimed than 0.919g/cm^3 , does not render embodiments of other densities not “preferred,” much less not adequately described or non-enabled. Applicants are permitted to selectively claim embodiments described and enabled in the disclosure over the course of prosecution. There is no prohibition against doing so.

To satisfy the enablement requirement of section 112, an application must disclose the claimed invention in sufficient detail to enable a person of ordinary skill in the art to make and use the claimed invention. To satisfy the written description requirement of section 112, the description must show that the applicant was in possession of the claimed invention at the time of filing. Both of these statutory requirements are satisfied here. The PTO bears an initial burden of setting forth a reasonable explanation as to why it believes that the scope of protection provided by the claim is not adequately described or enabled by the description of the invention provided in the specification of the application; this includes, providing sufficient reasons for doubting any assertions in the specification. In this case, the Examiner has provided no

cognizable bases to refute these two facts and therefore, the Examiner has not met his burden of providing a reasonable basis to question the description or enablement provided for the claimed invention.

Accordingly, Applicants respectfully request withdrawal of the §112, 1st paragraph rejection.

II. Response to Claim Rejection 35 U.S.C. § 103(a)- Ishikawa et al. (Ishikawa)

Claims 1, 2, and 5-9 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Ishikawa. The Examiner appears to assert that Ishikawa teaches all of the features of claim 1 except for a specific recitation of the polyolefin resins HDPE and LDPE which comprise the supporting substrate composition, together with their specific densities. However, the Examiner takes the position that one of ordinary skill would understand that the teachings of Ishikawa at col. 4, lines 12-18 would encompass the polyolefin species HDPE, LDPE and blends thereof. The Examiner finds further that fillers are also taught as suitable (Col 4, line 67) for incorporation into the polyolefin blends.

Applicants respectfully traverse the rejection.

The pressure-sensitive adhesive tape of the present invention is characterized in that the supporting substrate contains, as essential components, a high-density polyethylene and a low-density polyethylene having a density not more than 0.919 g/cm³, and that the substrate contains a filler such as calcium carbonate in an amount of not more than 5 parts by weight based on 100 parts of the resin composition constituting the substrate. The present invention is also characterized in that as the supporting substrate for pressure-sensitive adhesive tape, the resin

composition thereof is specified and the filler which is usually contained together with the resins is added in a specific amount or less.

An effect of adding the filler in an amount not more than 5 parts by weight is clear from a comparison between Example 1 adding no filler and Comparative Example 6 adding 10 parts by weight of a filler, with Example 1 having the same resin composition constituting the substrate as that of Comparative Example 6. That is, in the pressure-sensitive adhesive tape according to Comparative Example 6 adding 10 parts by weight of the filler, the elongation at break was 66 % which can not meet the range from 100 to 300% as defined in the present invention, and the pressure-sensitive adhesive tape has such a problem that it is liable to break in the longitudinal direction. In support, a Declaration under 37 C.F.R. § 1.132 is submitted herewith.

On the other hand, Ishikawa only describes that, when a base film of the pressure-sensitive adhesive tape is prepared, a filler (calcium carbonate) is added to a resin constituting the base film in a large amount of 10 to 20 % by weight. This is an embodiment corresponding to Comparative Example 6 of the present invention, by which the effect of the present invention cannot be achieved.

Accordingly, the present invention cannot easily be expected from Ishikawa which describes that the large amount of the filler is added in the base film of the pressure-sensitive adhesive tape. Thus, the present invention is patentable over the art of record.

In view of the above, Applicants respectfully request withdrawal of the §103 rejection.

III. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the

Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.


The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON DC SUGHRUE/265550

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CUSTOMER NUMBER


Jennifer M. Hayes
Registration No. 40,641

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